




Doc Code: AP.PRE.REQ

PTO/SB/33 (07-05)

Approved for use through xx/xx/200x. OMB 0651-00xx
U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

PRE-APPEAL BRIEF REQUEST FOR REVIEW		Docket Number (Optional) JP920030198US1							
I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)] on _____ Signature _____ Typed or printed name _____	Application Number 10/734,846	Filed 12/12/2003							
	First Named Inventor Manjeri Ramanathan Dharmarajan								
	Art Unit 2132	Examiner Devin E. Almeida							
<p>Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.</p> <p>This request is being filed with a notice of appeal.</p> <p>The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.</p> <p>I am the</p> <table border="0"><tr><td><input type="checkbox"/> applicant/inventor.</td><td rowspan="4"> _____ Signature Anthony V.S. England _____ Typed or printed name 512-477-7165 _____ Telephone number 3-18-2008 _____ Date</td></tr><tr><td><input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)</td></tr><tr><td><input checked="" type="checkbox"/> attorney or agent of record. 35,129 Registration number _____</td></tr><tr><td><input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 _____</td></tr></table> <p>NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.</p> <table border="1"><tr><td><input checked="" type="checkbox"/> *Total of <u>1</u> forms are submitted.</td></tr></table>				<input type="checkbox"/> applicant/inventor.	 _____ Signature Anthony V.S. England _____ Typed or printed name 512-477-7165 _____ Telephone number 3-18-2008 _____ Date	<input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)	<input checked="" type="checkbox"/> attorney or agent of record. 35,129 Registration number _____	<input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 _____	<input checked="" type="checkbox"/> *Total of <u>1</u> forms are submitted.
<input type="checkbox"/> applicant/inventor.	 _____ Signature Anthony V.S. England _____ Typed or printed name 512-477-7165 _____ Telephone number 3-18-2008 _____ Date								
<input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)									
<input checked="" type="checkbox"/> attorney or agent of record. 35,129 Registration number _____									
<input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 _____									
<input checked="" type="checkbox"/> *Total of <u>1</u> forms are submitted.									

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.

In the United States Patent and Trademark Office

In re the application of: Dharmarajan)

For: Method and apparatus for)
password generation)

App. No. 10/734,846)

Filing Date 12/12/2003)

Applicant's Docket:)
JP920030198US1)

Examiner: Devin E. Almeida

Art Unit: 2132

ARGUMENTS FOR PRE-APPEAL BRIEF REVIEW

Posture of the case

Claims 1-35 were originally filed. In a first Office action of February 22, 2007, claims 18-35 were rejected under 35 USC 101 on grounds that the invention claimed therein was directed to non-statutory subject matter. Amendments in Reply A, filed May 22, 2007, overcame the rejection.

The first Office action rejected claims 1-5, 10-12, 15, 18-22, 26-31 and 35 under 35 USC 102(a) as being anticipated by U.S. Patent 5,592,553 (Guski) and claims 6-9, 13, 14, 16, 17, 23-26, 32-35 under 35 USC 103(a) as being unpatentable over Guski in view of well-known practices in the art. In Reply A, Applicant amended claims to overcome the rejections, pointing out the novel and nonobvious differences of the present invention.

A second, final Office action of July 17, 2007, (the "Final Office Action") maintained and clarified the prior art rejections. Applicant then filed a Request for Reconsideration (the "RCE") of October 17, 2007, in which Applicant amended claims 1, 2, 18, 19, 27, and 28 to more certainly overcome the prior art rejections.

The current Office action of December 18, 2007, maintains the same rejection.

Issues

First Issue

One issue concerns claim language at the end of claim 1, for example, which recites “the generated first password is identical in its first and second instances if a time interval has been user specified but has not elapsed between the first and second times and if no time interval has been user specified for the first and second instances.”

The Final Office Action states, on page 2, “The Applicant is reminded that there is [sic] two ways to reject to that part of claim 1. The first way is the generated first password is identical in its first and second instance if no time interval has been user specified for the first and second instances. The second way is the generated first password is identical in its first and second instance if a time interval has been user specified but not elapsed between the first and second times.”

Applicant takes this to mean that the Final Office Action asserts it would be sufficient to sustain a rejection of the claim under 35 USC 102(a) if the prior art merely teaches a first “way,” in which “the generated first password is identical in its first and second instances if a time interval has been user specified but has not elapsed between the first and second times,” as claimed. Likewise, the Final Office Action asserts, a rejection of the claim would also be proper if the art merely teaches a second “way,” in which the generated first password is identical in its first and second instances if no time interval has been user specified for the first and second instances,” as claimed.

Applicant respectfully disagrees. As the claim is now worded, the prior art must teach both “ways” for a proper rejection of the claim. That is claim 1 states, “the generated first password is identical in its first and second instances if a time interval has been user specified but has not elapsed between the first and second times *and* if no time interval has been user specified for the first and second instances” (emphasis added).

Moreover, even if the Final Office Action were right about “two ways to reject,” the relied upon art teaches neither way. The rejection argues Guski, col. 6, line 61 - col. 7, line 3, teaches that a password is valid for a predetermined time interval, and that this anticipates either a password generator producing the same password “if no time interval has been user specified”

and “if a time interval has been user specified but has not elapsed” between certain times.
Applicant respectfully disagrees.

What the cited passage states is the following:

Password generator 300 is invoked when a user wishes to access a host application. When invoked, the password generator generates a one-time password 310 as a function of the user ID 302, application ID 304, signon key 306 and time/date 308. Password 310 is transmitted to the authenticating node 104, together with the user ID 302 and application ID 304, as part of a signon request 320.

Applicant respectfully submits that this actually teaches the *opposite* of that for which it is cited. That is, the passage teaches generating a “one-time password.” Generating a “one-time password” is directly contrary to generating the same password at two different times, i.e., in first and second instances, where the first instance is at a first time and the second instance is at a second time, as claimed. If Guski wanted to convey generating the same password at two different times, then using the type of terminology Guski did use, Guski might have said a “two-time password” or a “multiple-time password.” But this is not what Guski said.

Indeed, elsewhere Guski teaches about a time interval that is also directly contrary to what is claimed in the present case. That is, Guski states the following:

If the received password 310 does correspond to a legal password, then the password evaluator 312 determines whether the received password is identical to any valid password received over a predefined time interval (step 708); the interval is 10 minutes in the disclosed embodiment, but may be more or less if desired. If the received password is identical to a password received within the defined time interval, the just-received password is rejected as a “replay” of the previously received password (step 706). Since the valid password for a given used ID and application ID changes every second in the disclosed embodiment, the only realistic manner in which an identical password could be generated is by interception of a previously transmitted password (e.g., as it traverses the communications channel 106) and “replay” of that password by injecting it back into the system.

Col. 9, line 55 - col. 10, line 3.

In this passage, Guski teaches that if two instances of the same password are received during a predetermined time interval, the password is rejected, since Guski’s password generator *should not generate two identical passwords*. Note that limiting the testing of passwords for sameness to an interval such as 10 minutes is presumably merely due to the memory required to save received passwords for comparison, not because Guski teaches generating identical passwords after the 10 minute interval. Indeed, given that Guski teaches generating passwords as

a function of time/date 308, Gush's password generator should not generate two identical passwords at two different times.

So, Guski does not teach generating the same password in first and second instances either if no time interval has been user specified or if a user specified time interval has elapsed between instances. All the more certainly, Guski does not teach generating the same password in two instances both if no time interval has been user specified *and* if a user specified time interval has elapsed between instances, as now claimed.

Second Issue

Another issue concerns a rejection under 35 USC 112, which is presumably a rejection under the second paragraph of the cited section of the statute, since the rejection indicates the claim is allegedly indefinite. The Final Office Action, page 3, states "Claims 1-3, 18-20, and 27-29 are also indefinite because according to the remarks on page 12 of the RCE in trying to claim two different embodiments of the present invention in one claim which make the claim indefinite because it is unclear as to whether the password is time depend or not." Applicant respectfully disagrees.

In the first place, the Final Office Action states an erroneous proposition by asserting that it is somehow indefinite to claim something that is disclosed in two embodiments. The Final Office Action cites no authority for such a proposition.

Secondly, even if this erroneous proposition was the rule, the cited remarks of Applicant do not support the rule. Applicant's remarks on page 12 of the RCE stated that "...on page 7, line 18 - page 8, line 29, of the original specification, in connection with description of FIG. 3, the application clearly describes a single embodiment in which the user may either specify and time interval for a password or else not specify the time interval, and wherein the password generator responds accordingly in both circumstances. See especially page 8, lines 17-18, lines 21-22, and lines 29-30."

Thirdly, the claim is clear. Claim 1 indicates that if a user specifies no time interval in first and second instances of generating a password, then the password is the same in both instances. That is, the claim recites "the generated first password is identical in its first and second instances ... if no time interval has been user specified for the first and second


instances.” And the claim indicates that the password is also the same in both instances if a user has specified a time interval, but the time interval has not elapsed between a first time (when the password generator receives a first application name) and a second time (when the password generator receives the first application name again). That is, the claim recites “receiving a first application name by the password generator at a first time . . . generating a first instance of a first password for said first application . . . receiving said first application name again by the password generator at a second time; and generating a second instance of the first password for said first application by the password generator, wherein . . . the generated first password is identical in its first and second instances if a time interval has been user specified but has not elapsed between the first and second times . . .”

Arguments herein above have discussed claim 1 regarding two issues. However, the same issues and arguments also apply regarding claims 18 and 27, which have similar language according to the respective forms of the invention they claim. For at least the above reasons, Applicant submits that claims 1, 18 and 27 are allowable. Further, claims 2-10, 19-26 and 28-35 are allowable at least because they depend on allowable base claims.

REQUEST FOR ACTION

Based on the above arguments, Appellant requests that claims 1-10 and 18-35 of the present application be allowed and the application promptly be passed to issuance.

Respectfully submitted,

By 

Anthony V.S. England
Registration No. 35,129
Attorney of Record for
IBM Corporation
PO Box 5307
Austin, Texas 78763-5307
Telephone: 512-477-7165
a@aengland.com